

### **REMARKS**

Claims 40, 46, and 55 are amended, no claims are canceled, and no claims are added; as a result, claims 36-42, 45-49, and 51-56 are now pending in this application.

No new subject matter has been added by the amendments to claims 40, 46, and 55. Claim 40 is amended merely to clarify the language of the claim by deleting the word “containing” and to add the word “includes” in the claim. Claim 46 has been amended merely to delete the word “a” in two places in the claim. Claim 55 has been amended merely to delete the word “a” in one place in the claim.

#### **Petition to Make Application Special - Granted in the Application**

It is respectfully noted that a Petition to Make Special was filed in the application on August 21, 2006, and was granted on February 27, 2008.

In view of the status of the application as Special, Applicants’ representatives wish to work with the Examiner to gain an allowance in the application as quickly as possible. Based on a review of the claims now pending in the application, and on a review of the rejections cited in the Office Action, it is believed that, for at least the reasons stated in this response, the claims are patentable, and a Notice of Allowance including all pending claims in the application is respectfully requested.

If the Examiner disagrees, then it is respectfully requested that that the Examiner contact the Applicants’ representatives and grant the courtesy of a telephone interview in order to proceed with prosecution of the application in view of the Special status granted in the application.

#### **Claim Objections**

Claims 40 and 46 were objected to due to informalities.

According to the Office Action, “Claim 40 [was] objected to because of informalities: The grammatical wording creates uncertainty regarding the intended meaning of the amended limitation.”

In this response, claim 40 is amended to delete the word “containing” and to insert the word “includes” immediately following the phrase, “user table” in the claim. It is respectfully submitted that claim 40, at least as now amended, overcomes the objection to the claim.

According to the Office Action, “Claim 46 is objected to because of the following informalities: the limitation beginning with ‘accepting’ contains the ambiguous phrase ‘a search criteria’. This mix of the singular ‘a’ with the plural form of criterion ‘criteria’ creates the ambiguity regarding whether the limitation calls for one criterion or a plural criteria from the list which follows this statement.”

It is not necessarily agreed or admitted that these statements made in the Office Action related to claim 46 are correct. The recitation of criteria in a singular form is commonly used in English texts, and further, would not be ambiguous when viewed in terms of the use of the word in the claims in view of the specification of the application. However, in order to proceed to an allowance in the application, claim 46 has been amended to delete the word “a” immediately prior to the phrase “search criteria” in the claim, and also immediately prior to the phrase “specific criteria” in the claim.

A similar amendment has been made to independent claim 55 regarding the deletion of the word “a” immediately prior to the phrase “search criteria” in the claim. It is respectfully submitted that claim 46, at least as now amended, overcomes the objection to the claim.

Withdrawal of the objections to claims 40 and 46 is respectfully requested.

#### § 112 Rejection of the Claims

Claims 46-49 and 51-54 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The rejection is respectfully traversed.

According to the Office Action, “The scope of independent claim 46 is unclear because it is unclear how the limitations fulfill the purpose of the stated purpose in the preamble. No transaction occurs in the limitation.”

Applicants respectfully disagree. Attention is drawn to the specification of the present application, which states:<sup>1</sup>

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<sup>1</sup> See the specification as filed on page 4 at paragraph [0023].

For the purposes of the present specification, the term “transaction” shall be taken to include any communications between two or more entities and shall be construed to include commercial transactions including sale and purchase transactions, auctions, and the like.

In addition, the following are recited in claim 46:

“accepting at the network-based transaction facility a first request from a client machine,

...

communicating across the network to the client machine the sorted list for display at the client machine.”

It is respectfully submitted that, while it is not necessarily required as suggested by the Office Action, at least this subject matter, as recited in claim 46, includes one or more transactions. Further, claims 46-49 and 51-54 are not unclear, and meet the requirements of 35 U.S.C. § 112, second paragraph.

Reconsideration and withdrawal of the 35 U.S.C. § 112, second paragraph rejection is respectfully requested.

### § 103 Rejection of the Claims

Claims 35-42, 45-49 and 51-56 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Esposito et al. (U.S. Patent No. 6,587,838, hereinafter; “Esposito”) in view of Kopelman et al. (U.S. Patent No. 7,373,317, hereinafter; “Kopelman”), Offutt Jr. et al. (U.S. Publication No. 2002/0184059, hereinafter; “Offutt”), Levy et al. (U.S. Patent No. 7,428,505, hereinafter; “Levy”) and Van Horn et al. (U.S. Patent No. 6,934,690, hereinafter; “Van Horn”). The 35 U.S.C. § 103(a) rejection of claims 35-42, 45-49 and 51-56 is respectfully traversed.

Applicants respectfully submit that the rejection of claims 35-42, 45-49 and 51-56 based on the inclusion of Levy is improper under 35 U.S.C. § 103(c). Applicants respectfully submit that Levy is not eligible for use in rejecting claims 35-42, 45-49 and 51-56 of the present application in a 35 U.S.C. § 103 based rejection. A reference asserted under 102(e), (f), or (g) that was commonly owned with an application at the time the invention was made, cannot

preclude patentability under 35 U.S.C. § 103 of the claims of the application when the application was filed on or after November 29, 1999.<sup>2</sup> The present application was filed on December 14, 2001, claiming priority to U.S. Provisional Application 60/297,665 filed 6/11/2001, as shown by the attached copy of the Filing Receipt, which is after November 29, 1999.

Application 10/023,583 and U.S. Patent 7,428,505 B1 (Levy) were, at the time the invention of Application 10/023,583 was made, were owned by or subject to an assignment to eBay Inc. Applicants point to the following facts as proof of this assertion. First, Levy was assigned to eBay Inc. of San Jose, California in an assignment recorded July 18, 2000, as indicated on the face of the patent. It is believed that the assignment for this patent was recorded in the U.S.P.T.O. at Reel/Frame 011226/0621 on 07/18/2000. Second, the present application is also assigned to eBay Inc. of San Jose, California as evidenced by the assignment recorded at Reel/Frame 012397/0006, recorded 12/14/2001 in the U.S.P.T.O. Accordingly, Levy and the present application are commonly owned.

Accordingly, Applicants respectfully submit that Levy is disqualified as a prior art reference based at least on the above, and so Levy cannot preclude patentability with respect to the claims of the present application in a 35 U.S.C. § 103 based rejection. Therefore, the 35 U.S.C. § 103(a) is improper, and it is respectfully requested that the rejection be withdrawn, and all claim currently pending in the application be allowed.

However, and despite the fact that the above stated 35 U.S.C. § 103(a) rejection is improper, it is respectfully submitted that even if this rejection could be made, claims 35-42, 45-49, and 51-56 are still patentable in view of the rejection for at least the reasons stated below.

Applicants maintain each of the arguments provided in Applicants' previous response<sup>3</sup> electronically filed in the application by Applicants' Representatives on July 16, 2009. In the Previous Response, it was shown that any proposed combination of Esposito, Kopelman, and Offutt fails to disclose or suggest all of the subject matter in any given one of the pending claims in the application, including for example independent claim 36.

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<sup>2</sup> See 35 U.S.C. § 103(c); 1233 OG 55 (April 11, 2000).

<sup>3</sup> See the response filed July 16, 2009 using the USPTO's efilings system, hereinafter referred to as the "Previous Response."

As noted in the Previous Response, independent claim 36 includes subject matter not disclosed or suggested by any proposed combination of Esposito, Kopelman, and Offutt, including the following:

the at least one back-end server operable to search a database maintained by the network-based transaction facility, wherein the network-based transaction facility includes a database engine server coupled to at least one engine server database including a user table, the engine server database includes an items table that is linked to the user table and that includes a sellers items table and a bidders items table, **wherein the items table includes a number of fields for each of a plurality of records that describe an item offered for sale via the network-based transaction facility, wherein at least one of the number of fields includes a sale type field operable to record a type of item that indicates a price-setting process by which a price for the item relevant to the record associated with the item being offered for sale is established,** the database including at least one item offered for sale using an auction-type price setting process and at least one item offered for sale using a fixed price setting process;

...  
wherein the commingled list includes items being offered for sale by any combination of an auction-type price setting process and a fixed price setting process, **and wherein if the request includes a specified transaction type, the at least one back-end server is operable to filter the commingled list to include only items offered for sale that have a type of item in the sale type field for the item offered for sale that matches the specified transaction type.** (Emphasis added)

As established in the Previous Response, any proposed combination of Esposito, Kopelman, and Offutt fails to disclose or suggest at least this subject matter included in independent claim 36.

In an attempt to remedy these deficiencies, the currently pending Office Action now adds the additional documents of Levy and Van Horn to the statement of the 35 U.S.C §103(a) rejection. However, even if these two documents could be combined with Esposito, Kopelman,

and Offutt,<sup>4</sup> the proposed combination of documents still fails to disclose or suggest all of the subject matter in any given one of the pending claims in the application, including the subject matter of independent claim 36 as quoted above.

In contrast to the subject matter of independent claim 36, the portion of Van Horn cited in the Office Action concerns:

The seller's screen 800 includes a name field 801, and address field 802, a goods for sale field 803, a maximum quantity field 804, and a description of goods field 805. . . . The goods for same field 803 allows the seller to enter a name for the goods being sold . . . .<sup>5</sup>

In addition, the portion of Levy cited in the Office Action concerns:

The database 23 also includes item tables 42 that may be linked to the user table 40. Specifically, the table 42 include seller items table 44 and a bidder items table 46.<sup>6</sup>

Thus, any “sale field” discussed in Van Horn relates to *a name for the goods to be sold*, but fails to disclose or suggest the subject matter of independent claim 36, including, “wherein at least one of the number of fields includes a sale type field operable to record a type of item that indicates a price-setting process by which a price for the item relevant to the record associated with the item being offered for sale is established,” as included in independent claim 36.

The Office Action fails to show how the addition of Levy remedies these deficiencies of Esposito, Kopelman, and Offutt, and Van Horn.

Further, since the Office Action fails to show how the proposed combination of documents cited in the rejection of claim 36 discloses or suggests this subject matter of claim 36, the Office Action also fails to show how this proposed combination of documents discloses or suggests, for example, “wherein if the request includes a specified transaction type, the at least one back-end server is operable to filter the commingled list to include only items offered for

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<sup>4</sup> Applicants do not admit or agree that any combination or combinations of Esposito, Kopelman, Offutt, Levy, and Van Horn are possible.

<sup>5</sup> See Van Horn at column 11, lines 22-29.

<sup>6</sup> See Levy at column 3, lines 48-50.

sale that have a type of item in the sale type field for the item offered for sale that matches the specified transaction type,” as also included in indent claim 36.

Therefore, independent claim 36 is not obvious in view of the proposed combination of Esposito, Kopelman, Offutt Jr., Levy, and Van Horn.

For reasons analogous to those stated above with respect to independent claim 36, independent claims 46 and 55 are also not obvious in view of any proposed combination of Esposito, Kopelman, Offutt, Levy, and Van Horn.

Claims 37-42, 45, 47-49, 51-54, and 56 depend from one of independent claims 36, 46, and 55. For at least the reasons stated above, claims 37-42, 45, 47-49, 51-54, and 56 are not obvious in view of the proposed combination of Esposito, Kopelman, Offutt, Levy, and Van Horn.

*The Office Action improperly applies In re Harza in an attempt to avoid giving patentable weight to the language of the claims.*

The Office Action refers to *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) in an improper effort to avoid giving patentable weight to the language of the currently pending claims in the application. For example, the Office Action states:

The following limitations are not given patentable weight because repetition of a method step is not considered to have patentable novelty (In re Harza):

“accepting at the network-based transaction facility a second requirement from the client machine, the second require to sort the commingled list by a specific criteria, wherein the specific criteria includes a specific transaction type of the plurality of transaction types;

using the sales type field from the items table, looking up in the items table the specified transaction type to determine if any of the items from the commingled list meet the requirements for the specified transaction type by comparing the specified transition type to the sales type field in the items table;

generating a sorted list, the sorted list sorted to include only items offered for sale by the seller that meet the specified transaction types included in the second request; and

communicating across the network to the client machine and sorted for display at the client machine.”

These statements as provided in the Office Action are respectfully traversed. First, the Office Action is required to give patentable weight to each and every word included in the claims.

The Office Action fails to explain how the case *In re Harza* provides permission for the Examiner to not give patentable weight to the above-quoted language as included in the claims of the application.

Further, it is respectfully submitted that *In re Harza* concerns *duplication of parts*, and does not address “method steps” as suggested by the Office Action. The following is taken from the MPEP quoting *In re Harza*:

#### **B. Duplication of Parts**

*In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960) (Claims at issue were directed to a water-tight masonry structure wherein a water seal of flexible material fills the joints which form between adjacent pours of concrete. The claimed water seal has a “web” which lies in the joint, and a **plurality of “ribs” projecting outwardly from each side of the web into one of the adjacent concrete slabs**. The prior art disclosed a flexible water stop for preventing passage of water between masses of concrete in the shape of a plus sign (+). **Although the reference did not disclose a plurality of ribs, the court held that mere duplication of parts has no patentable significance unless a new and unexpected result is produced.**)<sup>7</sup>

(Emphasis added)

Further, the following is taken from the language of *In re Harza*:

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<sup>7</sup> See *Manual of Patent Examining Procedure*, Eighth Edition, August 2001, Latest Revision July 2008 at Section 2144.01.

The board, in affirming the examiner, stated that the claims were unpatentable over Gardner alone and that it was not “necessary to rely on either Roberts or Schurman.

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The only distinction to be found in the recitation in claim 1 of the plurality of ribs on each side of the web whereas Gardner shows only a single rib on each side of the web. It is well settled that the **mere duplication of parts** has no patentable significance unless a new and unexpected result is produced, and we are of the opinion that such is not the case here.<sup>8</sup>

(Emphasis added).

Thus, *In re Harza* relates to *duplication of parts*, but does not mention “method steps”, as suggested in the Office Action. Further, as shown in *In re Harza*, the court did not suggest that that the subject matter of claim 1 did not give patentable weight, as suggested by the Office Action. Instead, *In re Harza* indicated that duplication of parts in a claim does not provide patentable significance unless a new and unexpected result is produced. The patentable significance of the duplicate part was viewed relative to the disclosure of the cited art, and was not merely discarded as having no patentable weight merely for being a duplication of parts.

In other words, the court did not say that this subject matter did not give patentable weight in view of the cited reference Gardner, but that the duplicate of parts did not *provide patentable significance* over Gardner. This is quite different from not giving claimed subject patentable weight to claimed subject matter. That is, *In re Harza* does not mean that subject matter does not need to be considered at all in view of any prior art, as is being suggested by the Office Action. Thus, the Office Action is required to give patentable weight to the subject matter included in the claims as pending in the Office Action.

Further, the Office Action fails to show how the subject matter of claim 46 is duplicated, and thus would not be patentably significant in view of the documents cited in the Office Action, even if the ruling in *In re Harza* were applicable to the subject matter of claim 46, or specifically how any “duplication” is present in the claims.

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<sup>8</sup> See *In re Harza* at 671.

Still further, as discussed above, the Office Action fails to show how the proposed combination discloses or suggests this subject matter, and therefore, even if duplication of “method steps” as referred to by the Office Action did exist in the claims, the Office Action fails to show how *any of this subject matter* is disclosed or suggested in the cited documents.

For at least the reasons stated above, the Office Action fails to meet its required burden to establish a *prima facie* case of obviousness with respect to claims 36-42, 45-49 and 51-56.

Reconsideration and withdrawal of the rejection and allowance of claims 35-42, 45-49, and 51-56 is respectfully requested.

Claim 48.

Claim 48 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Esposito in view of Kopelman and Offutt Jr. as applied to claim 46 above, and further in view of O'Neill et al. (U.S. Patent No. 5,987,440, hereinafter; “O’Neil”).

Claim 48 depends from independent claim 46, and so includes all of the subject matter included in independent claim 46, and more. For at least the reasons stated above with respect to independent claim 46, any proposed combination of Esposito, Kopelman, and Offutt Jr. fails to disclose or suggest all of the subject matter included in claim 48. The addition of O'Neill fails to remedy these deficiencies in the proposed combination of Esposito, Kopelman, and Offutt Jr. Thus, the proposed combination of Esposito, Kopelman, Offutt Jr., and O'Neill<sup>9</sup> fails to disclose or suggest all of the subject matter included in claim 48, and so claim 48 is not obvious in view of the proposed combination of Esposito, Kopelman, Offutt Jr., and O'Neill.

Reconsideration and withdrawal of the 35 U.S.C. § 103(a) rejection, and allowance of claim 48, is respectfully requested.

Reservation of Rights

In the interest of clarity and brevity, Applicants may not have addressed every assertion made in the Office Action. Applicants’ silence regarding any such assertion does not constitute any admission or acquiescence. Applicants reserve all rights not exercised in connection with

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<sup>9</sup> Applicants do not admit or agree that any proposed combination or combinations of Esposito, Kopelman, Offutt Jr., and O'Neill are possible.

this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicants do not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicants timely object to such reliance on Official Notice, and reserve all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicants reserve all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. If the claims are not considered in proper form for allowance, the Examiner is invited to telephone the undersigned at (612) 371-2132 to facilitate prosecution of this application.

If necessary, please charge any additional fees or deficiencies, or credit any overpayments to Deposit Account No. 19-0743.

Respectfully submitted,

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Date 28 January 2010

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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 28th day of January, 2010.

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